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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/525,488	03/15/2000	Steve Sheppard	6019.3022	9809

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EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2611

DATE MAILED: 03/29/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

200

# Office Action Summary

Application No.

09/525,488

Applicant(s)

SHEPPARD ET AL.

Examiner

Brown M. Reuben

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6, 11, 19, 24, 31, 38, & 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroiwa, (U.S. Pat # 5,715,020).

Considering claims 1, 6, 11, 19, 24 & 31, the claimed residential gateway and method for receiving and decoding signals from a telecommunications network and transmitting the decoded signals to a plurality of devices, including multiple TV's, comprising connecting the residential gateway to the telecommunications network and to each of the plurality of devices so that all communications between the network and the devices must pass through the residential gateway, is met by operation of the HIB 500, (Fig. 29; Fig. 40). The claimed feature of selecting a TV channel to view for at least one of the TV's by transmitting a channel select command to a receiver within the residential gateway reads on Kuroiwa, col. 5, lines 30-36 & col. 9, lines 15-45.

The claimed feature of transmitting the at least one channel select command to the telecommunications network is met by Kuroiwa, (col. 8, lines 48-50; col. 18, lines 30-67; col. 25, lines 1-14. The additionally claimed features of receiving a video signal from the telecommunications network corresponding to the at least one channel select command, converting the video signal into at least one series of packets, decoding the series of video signals into a TV signal, by at least one of a plurality of video decoders, and transmitting the TV signal to the appropriate TV is met by Kuroiwa, (col. 8, lines 54-63; col. 12, lines 51-65 & col. 26, lines 11-21). As for the plurality of video decoders Kuroiwa, discloses a plurality of moving picture processors 504 (Fig. 3; col. 10, lines 1-5).

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Regarding claims 6 & 19, the instant claims recite that the remote control is an optical remote control device, which is disclosed by Kuroiwa, (col. 27, lines 21-33; col. 34, lines 22-25). Transmission/reception of optical signals reads on the use of IR technology.

Considering claims 38 & 43, the claimed features correspond with subject matter mentioned above in the rejection of claims 24 & 31, and are likewise analyzed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, <sup>6-16, 19-23</sup>~~6-19~~ & 43-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Eames, (U.S. Pat # 6,317,884).

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Considering claims 1 & 6, the claimed method of distributing video signals from a residential gateway in a residential environment having a plurality of TV's located in at least two separate locations, comprising receiving at least one channel select command from one of a plurality of remote control devices associated with a respective one of the plurality of TV's, wherein the remote control transmits the channel select command as a wireless signal, is met by the disclosure of Eames, (Fig. 1; Fig. 5; Fig. 7; col. 6, lines 62-67; col. 7, lines 12-25). The claimed residential gateway reads on the gateway 200, and the remote control reads on the wireless remote 500.

The claimed method of receiving a video signal from a telecommunications network in response to the at least one channel select command, and constructing from the signal at least one series of video packets, is met by the operation of the NIM 410 and the MPEG processor 430. As disclosed, the NIM 410 receives digital (video) services from a network, via a coaxial cable 180 or twisted pair wire drop 170, whereas the MPEG processor 430 constructs MPEG packets from a received ATM stream, (col. 4, lines 14-20).

The claimed transporting the at least one series of video packets over a video packets bus to a plurality of video decoders reads on the routing of MPEG data over buses 429 to a plurality of MPEG modules 450, which decompresses the MPEG data, see col. 6, lines 5-22 & col. 7, lines 50-57. Thus, the claimed decoding the at least one series of video packets to produce a TV signal is also met by the disclosure of Eames.

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Regarding claim 6, the instant claim recites that the remote control is an optical remote, which is also disclosed by Eames, (col. 5, lines 65-67 thru col. 6, lines 1-4). The above-cited passage teaches that a remote control block 442 has an interface to an IR receiver 472, which can receive command directly from a remote control operated within the vicinity of the gateway 200. Transmission/reception of optical signals reads on the use of IR technology.

Considering claims 2, 9, 12, 22 & 46, the claimed remote antenna package connected to a TV, which receives the wireless signal from the remote control device is met by the operation of the IR receiver 710, located at a TV set 199, (Fig. 7; col. 6, lines 1-4; col. 7, lines 26-30).

Considering claims 3, 10, 13, 23 & 47, the claimed feature of receiving the wireless signal from the media at a remote antenna module located in close proximity to the residential gateway, demodulating the wireless signal and extracting the channel select command, and transmitting the channel select command to the residential gateway reads on the operation of the UHF RX 470, disclosed in Fig. 4, col. 6, lines 1-4.

Considering claims 7, 20, 25 & 44 the claimed optical receiver, which is an integral part of the residential gateway is met by the IR receiver 472, (Fig. 4 & Fig. 6).

Considering claims 8, 21 & 45, see col. 6, lines 49-51.

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Considering claims 11 & 19, the claimed elements within a residential gateway for distributing video signals to a plurality of TV's located in at least two separate locations corresponds with subject matter mentioned above in the rejection of the method claims 1 & 6, and are likewise treated.

Considering claims 14-16, Fig. 4 of Eames shows that a UHF RX antenna 470 may be connected to the residential gateway 200, which also reads on the recitation of being in close proximity. As for the claimed feature of being an integral part of the residential gateway, the instant feature also reads the operation of UHF RX 470, in the sense that the antenna module receives remote control signals and delivers to the control block 442. Examiner notes that claim 16 does not require that the antenna module is integrated within the residential gateway.

Considering claim 43, the claimed residential gateway for receiving and decoding signals from a telecommunications network and transmitting the decoded signals to a plurality of devices, comprising a network interface module for receiving the video signals, is met by the NIM 410 of Fig. 5 & Fig. 7, (col. 5, lines 47-53). The claimed plurality of video decoders for decoding the video signals into at least one TV signal, corresponding to at least one channel select command and transmitting the at least one TV signal to the corresponding TV is met by the operation of the MPEG modules 450, (col. 6, lines 5-21). The claimed receiver for directly receiving channel select commands from at least one remote control device associated with one of the multiple receivers is met by the IR receiver 710, (col. 7, lines 25-29).



***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5, 17-18, <sup>2426-42</sup>~~24-42~~ & 48-50 are rejected under 35 U.S.C. 103(a) as being obvious over Eames.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this

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rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Considering claims 4-5, 17-18, Eames teaches that the remote control devices are enabled to utilize wireless technology, but does not specify the frequency channel used. Official Notice is taken that at the time the invention was made, it was well known to transmit/receive data from a remote control device to receiver over a particular frequency. It would have been obvious for one ordinary skill in the art at the time the invention was made, to include within Eames the feature of transmission/reception of data from a remote control over a specific frequency, at least for the known purpose of avoiding interference with other appliances at their respective transmission/reception frequency.

Considering claims 24 & 31, the claimed residential gateway and method for receiving and decoding signals from a telecommunications network and transmitting the decoded signals to a plurality of devices, including multiple TV's, comprising connecting the residential gateway to the telecommunications network and to each of the plurality of devices so that all communications between the network and the devices must pass through the residential gateway, is met by Fig. 1; Fig. 5 & Fig. 7. The additional features that one of the TV's can be in close proximity and directly coupled to the gateway, is met by col. 4, lines 40-45.

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As for the claimed feature of transmitting the at least one TV signal to the appropriate TV, the claimed feature is necessarily included in Eames, col. 7, lines 5-11.

The additionally claimed features of selecting a TV channel, via a remote control, which wirelessly transmits the channel select command to a receiver, receiving a video signal in response to the channel select command, converting the video into a series of packets, and decoding the video signals at least one of a plurality of decoders corresponds with subject matter mentioned above in the rejection of claims 1 & 11, and are likewise analyzed.

As for the further claimed feature of transmitting the channel select command to the communications network, Eames discloses that the NIM 410 will contain the appropriate modem technology, for the particular network which it is communicating with, col. 5, lines 42-46. Modem technology necessarily features two-way communication, however it is not explicitly disclosed that the two-way communication is used to transmit at least one channel select command to the telecommunications network.

Nevertheless, Official Notice is taken that at the time the invention was made, it was very well known in the art to transmit user program selection commands upstream over a network, from a subscriber terminal to a CATV headend or hub. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Eames with the technique of upstream signaling over a network, for program/channel selection in a two-way communication manner, at least for the known benefit of enabling the subscriber to access a

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wider range of programming, which may reside at the headend, as opposed the subscriber only having access to programs/channels which are transmitted to the subscriber terminal, for one-way communication.

Considering claims 26-27 & 33-34, Eames teaches the use of S-video technology to transmit video from the residential gateway 200, to at least one TV set 199, see col. 4, lines 36-45; col. 5, lines 62-64 & col. 7, lines 5-11.

Considering claim 28, Official Notice is taken that at the time the invention was made, it was well known in the art to program a remote control device to control more than one receivers, such as set top boxes and TV's. It would have been obvious for one ordinary skill in the art at the time the invention was made, to include in Eames the known feature of programming a remote control device to operate a plurality of receivers, at least for the desirable improvement of reducing the number of needed remote control devices.

Considering claims 29, 36 & 41, the claimed remote antenna package connected to a TV, which receives the wireless signal from the remote control device is met by the operation of the IR receiver 710, located at a TV set 199, (Fig. 7; col. 6, lines 1-4; col. 7, lines 26-30).

Considering claims 30, 37 & 42, the claimed feature of receiving the wireless signal from the media at a remote antenna module located in close proximity to the residential gateway, demodulating the wireless signal and extracting the channel select command, and transmitting

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the channel select command to the residential gateway reads on the operation of the UHF RX 470, disclosed in Fig. 4, col. 6, lines 1-4.

Considering claims 32 & 39, the claimed optical receiver, which is an integral part of the residential gateway is met by the IR receiver 472, (Fig. 4 & Fig. 6).

Considering claims 35 & 40, see col. 6, lines 49-51.

Considering claim 38, the claimed method for receiving and decoding signals from a telecommunications network, which corresponds with subject matter mentioned above in the rejection of claims 24 & 31, are likewise analyzed. As for the additionally claimed feature programming an associated remote control device, the claimed feature reads on instructing the remote control to select a channel, i.e. selecting a channel.

Considering claim 48, the claimed method for receiving and decoding signals from a telecommunications network at a residential gateway comprises features which correspond with subject matter mentioned above in the rejection of claim 24 & 31, and is likewise analyzed. The claimed feature of programming an associated wireless remote control reads on instructing the remote control to select a channel, i.e. selecting a channel.

Considering claims 49 & 50, the claimed residential gateway for receiving and decoding signals from a telecommunications network and transmitting the decoded signals to a plurality of

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devices including multiple TV's, such that the residential gateway comprises a network interface module for receiving downstream video signals from telecommunications network reads on the NIM 410, (col. 5, lines 35-53). Regarding the additional feature of transmitting upstream signals, including channel select commands to the communications network, corresponds with subject matter mentioned above in the rejection of claims 24 & 31, and are likewise analyzed. The claimed plurality of video decoders reads on MPEG modules 450.

The claimed remote control module for processing the channel select command, wherein the channel select command is extracted from a wireless signal is met by the IR receiver 710, col. 7, lines 25-30. The claimed remote antenna package connected to the associated TV, which transmits the wireless signal over a media to a remote antenna module, which demodulates the wireless signal and extracts the corresponding video, as per the channel select command, is met by the IR receiver 710.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Chanteau      Generically discloses transmitting upstream signaling from a user terminal to a network headend, (col. 3, lines 21-25).

B) Bodeep      Discloses numerous detailed algorithms for transmitting upstream signaling from a user terminal to a network headend, (col. 3, lines 50-67; col. 4, lines 36-51).

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Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Brown M. Reuben whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9314 for regular  
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Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600